

REMARKS

Disposition of the Claims

Claims 1-30 are pending in this application. In the non-final Office Action mailed April 21, 2005, the Examiner rejected claims 1-5, 11-12, 23-26, 28 and 29 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication 2004/0211834 A1 to *Fleckenstein et al.* ("*Fleckenstein*") and rejected claims 6-10, 13-22 and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0128207 A1 to *Ray* in view of U.S. Patent Application Publication 2004/0193314 A1 to *Tiles et al.* ("*Tiles*"). Applicants respectfully traverse the Examiner's rejections for the reasons provided below.¹

Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-5, 11-12, 23-26, 28 and 29 under 35 U.S.C. § 102(b) as being anticipated by *Fleckenstein*. To qualify as prior art under 35 U.S.C. § 102(b) the publication or issue date of a reference must be more than one year prior to the effective filing date of an application (See M.P.E.P. § 706.02(a) (8th ed. 2001)). The publication date of *Fleckenstein* was October 28, 2004. Applicants note that *Fleckenstein* is a continuation-in-part of U.S. Patent Application No. 09/815,745, now U.S. Patent No. 6,634,551 to *Barta et al.* (hereinafter "*Barta*"), which was first published as U.S. Patent Application Publication No. 2002/0138173 on September 26, 2002. In

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

comparison, the effective filing date of the present application is October 13, 2000 based on a claim of priority to U.S. Provisional Patent Application No. 60/239,926. Because the publication date of both *Fleckenstein* and *Barta* are later than the effective filing date of this application, these references do not qualify as prior art under 35 U.S.C. § 102(b). Accordingly, the rejection under 35 U.S.C. § 102(b) is improper. Applicants, therefore, respectfully request that the Examiner withdraw the rejection claims 1-5, 11-12, 23-26, 28 and 29 under 35 U.S.C. § 102(b).

Applicants note that *Fleckenstein* may qualify as prior art under 35 U.S.C. § 102(e) based on the reference's claim to the benefit of U.S. Provisional Application No. 60/203,402 (hereinafter the "Provisional Application") filed on May 11, 2000. In rejecting claims 1, 5, 11 and 12, the Examiner relies on page 1, paragraph 13 of *Fleckenstein*. Applicant's, however, cannot find this subject matter in the Provisional Application. Because this subject matter of *Fleckenstein* is not disclosed in the Provisional Application, it is not entitled to the benefit of the Provisional Application's filing date. Rather, this subject matter appears to have been first disclosed in *Fleckenstein* and, therefore, is only entitled to *Fleckenstein's* filing date of May 18, 2004. Consequently, this subject matter also does not qualify as prior art under 35 U.S.C. 102(e). If the Examiner maintains that the subject matter of *Fleckenstein* relied on in the rejection of claims 1-5, 11-12 is supported by the Provisional Application, Applicants respectfully request that the Examiner specifically point out the location where the subject matter is disclosed in the Provisional Application.

Moreover, claim 1 recites a method for changing the delivery point of an item while the item is en route including, *inter alia*, “determining a first delivery point of the item; notifying, based on the first delivery point, a recipient that the item is en route; accepting at least one instruction designating a second delivery point.” The Provisional Application fails to disclose at least these elements of claim 1. Because the Provisional Application fails to disclose at least these elements of claim 1, the Provisional Application cannot support a rejection under 35 U.S.C. 102(e) of claim 1, or claims 2-4 which depend from claim 1.

Further, claims 2-4 depend from claim 1. Because the Provisional Application does not anticipate claim 1, the Provisional Application cannot anticipate claims 2-4 under 35 U.S.C. 102(e) due to their dependency from claim 1.

Claims 5, 11 and 12, although of different scope than claim 1, recite subject matter similar to that of claim 1. Accordingly, the Provisional Application also cannot anticipate claims 5, 11 and 12 under 35 U.S.C. 102(e).

Claims 23-26, 28 and 29 are rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by *Fleckenstein*. Claims 23-26, 28 and 29 depend from claim 14, which requires “providing a notification to indicate that the item is en route to the first delivery point; conditionally accepting a second delivery point of the item.” But “providing a notification to indicate that the item is en route” is not disclosed in

Fleckenstein and, accordingly, *Fleckenstein* does not anticipate claim 14, or claims 23-26, 28 and 29, which depend therefrom.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 6-10, 13-22 and 30 under 35 U.S.C. § 103(a) as being unpatentable over *Ray* in view of *Tiles*. (Office Action, page 5, lines 17-21.) *Ray* is disqualified as prior art under 35 U.S.C. § 103(c) because Application No. 09/976,039 (the present application) and U.S. Patent Application Publication 2004/0128207 A1 (*Ray*) were subject to an obligation of assignment to the United States Postal Service at the time the invention of Application No. 09/976,039 was made. (See M.P.E.P. § 706.02(I) (8th ed. 2001).) Because *Ray* is disqualified as prior art under 35 U.S.C. § 103(c), it cannot support a rejection under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request the Examiner withdraw his rejection of claims 6-10, 13-22 and 30 under 35 U.S.C. § 103(a).

Allowability Claim 27

The Examiner did not reject claim 27. Therefore, Applicants submit that claim 27 is allowable over the prior art and respectfully request that the Examiner allow the claim.

Conclusion

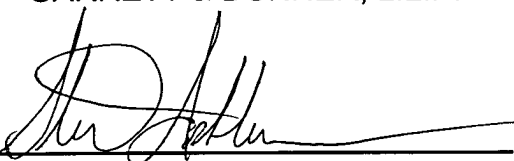
Applicants request reconsideration of the application and submit that the rejections detailed above should be withdrawn. Further, Applicants submit that pending claims 1-30 are in condition for allowance, and request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 20, 2005

By: 
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